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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,402	06/16/2000	Oscar Jimenez	P-9399.00	3509

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EXAMINER

BRADFORD, RODERICK D

ART UNIT PAPER NUMBER

3762

17

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/596,402

Applicant(s)

JIMENEZ ET AL.

Examiner

Roderick Bradford

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 26, 2003 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed November 26, 2003 have been fully considered but they are not persuasive.

"An axis" for the recharging coil has not been defined. The "axis" could be the x, y, or z-axis and also neither the distal side or the proximal sides has been defined. See attachment.

### ***Claim Rejections - 35 USC § 102/103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-8, 10, 11, 13, 14 and 17-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kelly et al. U.S. Patent No. 4,041,955.

Referring to claim 1, Kelly discloses an implantable medical device comprising:

- Electronics carried in the housing and configured to perform a medical therapy
- A rechargeable power source carried in the housing and coupled to the electronics (Fig 3)
- A secondary recharging coil coupled to the electronics and rechargeable power source (21)
- A magnetic shield placed on the distal side of the receiving coil to improve recharging efficiency (column 5, lines 22-26)

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It is inherent that the housing has an electrical feedthrough since it has leads extending through the housing. In the alternative Kelly discloses the claimed invention except for an electric feedthrough. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention as taught by Kelly, with an electrical feedthrough since it is well known in the art that implantable devices have electrical feedthroughs for providing energy.

Referring to claim 18, wherein the secondary recharging coil is an external secondary charging coil located away from the housing (Fig 2).

Referring to claim 19, wherein the recharging coil is located in the housing interior cavity (Fig 3).

7. Claims 1-8, 10, 11, 13, 14 and 17-22 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zarinetchi et al. U.S. Patent No. 6,324,431.

Referring to claim 1, Zarinetchi discloses an implantable medical device comprising:

- Electronics carried in the housing and configured to perform a medical therapy
- A rechargeable power source carried in the housing and coupled to the electronics (Fig 3)
- A secondary recharging coil coupled to the electronics and rechargeable power source (21)

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- A magnetic shield placed on the distal side of the receiving coil to improve recharging efficiency (column 5, lines 22-26)

It is inherent that the housing has an electrical feedthrough since it has leads extending through the housing. In the alternative Zarinetchi discloses the claimed invention except for an electric feedthrough. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention as taught by Kelly, with an electrical feedthrough since it is well known in the art that implantable devices have electrical feedthroughs for providing energy.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly (or Zarinetchi) et al. U.S. Patent No. 4,041,955 in view of Schulman et al. U.S. Patent No. 6,067,474.

Referring to claim 12, Kelly (or Zarinetchi) fails to disclose wherein the magnetic shield includes eddy cuts to reduce eddy current flow through the magnetic shield. However, Schulman includes eddy cuts to reduce eddy current flow through the magnetic shield (Fig. 3A-C) as a means of more accurately and efficiently improve charging.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Kelly, as taught by Schulman, to include eddy cuts to reduce eddy current flow through the magnetic shield (Fig. 3A-C) as a means of more accurately and efficiently improve charging.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly (or Zarinetchi) et al. U.S. Patent No. 4,041,955.

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Kelly (or Zarinetchi) discloses the claimed invention except for wherein the device further comprises a second insulator placed between a second magnetic shield and a third magnetic shield. It would have been an obvious matter of design choice to one skilled in the art to modify the teachings of Kelly (or Zarinetchi), since the applicant has not disclosed that a second insulator placed between a second magnetic shield and a third magnetic shield provides any criticality and/or unexpected results and it appears that the invention would perform equally as well with any insulator placed between a second magnetic shield and a third magnetic shield, such as the insulator and shield as taught by Kelly (or Zarinetchi) as a means of protecting the shields..

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly (or Zarinetchi) et al. U.S. Patent No. 4,041,955.

Kelly (or Zarinetchi) discloses the claimed invention except for wherein the first and second insulator are selected from the group consisting of: plastic, mylar, and tape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device as taught by Kelly (or Zarinetchi), with a first and second insulator selected from the group consisting of: plastic, mylar, and tape since it is well in the art that plastic, mylar, and tape have very good insulating properties and are used in implantable devices as insulators.

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**Conclusion**

The Kelly et al. reference and the Zarinetchi covers the majority of the claims inherently and the Kelly et al. reference is capable of performing the functional use recitations presented in the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Bradford whose telephone number is (703) 305-3287. The examiner can normally be reached on Monday - Friday 7 a.m. - 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
R.B.  
December 11, 2003



ANGELA D. SYKES  
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